

### **REMARKS**

Applicant hereby responds to the Office Action of August 7, 2008, in the above-referenced patent application. Applicant thanks the Examiner for carefully considering the application.

#### **Status of Claims**

After this amendment, claims 20-34 are currently pending. Claims 20, 28 and 32 are independent.

Claims 20-32 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,758,257 ("Herz").

#### **Claim Amendments**

By way of this reply, new claim 33 is added. No new matter has been added.

#### **Rejection under 35 U.S.C. §102(b)**

Rejection of claims 20-32 is respectfully traversed because, for at least the following reasons, Herz fails to show or suggest all of the claimed limitations.

According to MPEP §2131,

'[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' (*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). 'The identical invention must be shown in as complete

detail as is contained in the ... claim.’ (Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, *i.e.*, identity of terminology is not required. (In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)).

The claimed invention is directed to a system and method for personalizing TV.

Independent claim 20 requires, in part, “presenting the viewer with *a first list of TV programs* available for viewing, the programs selected and arranged in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer after viewing the first list, the input requesting different selections than in the first list*; and presenting the viewer with *a second list including alternative TV programs available for viewing*” (emphasis added).

Independent claim 28 requires, in part, “presenting the viewer with one of *a first list of the selected programs and an alternative second list of programs*, the first list arranged in accordance with the viewer characteristics information profile, and the second list arranged in accordance with an alternate viewer characteristics information profile, wherein *the second list is based on feedback input from the viewer of the first list*” (emphasis added). Independent claim 32 requires, in part, “presenting the viewer with a first list of the selected programs, the first list arranged without viewer input in accordance with the viewer characteristics information profile; *receiving feedback input from the viewer about the first list*; and *presenting the viewer with a second list of selected programs based on said feedback input*” (emphasis added).

Herz fails to disclose or suggest at least the above-mentioned limitations.

It is asserted in the Office Action that Herz discloses receiving feedback input from the viewer after viewing the first list, the input requesting different selections than the first list and presenting the viewer with a second list including alternative TV programs for viewing. Applicant strongly disagrees for the following reasons. Herz discloses that customer profiles are updated based on whether a show that was predicted to be watched by a viewer was not watched (Herz, col. 26, line 64-col. 27, line 1). The updating of the profile is done by use of passive monitoring (Herz, col. 26, line 57-60). Therefore, it is clear that while a viewer's profile is updated, no viewing list is updated. And, the viewer does not receive any feedback input from the viewer after viewing a first list as the viewer in Herz simply watches a show or not. Further, as passive monitoring is used in Herz, the viewer is not requesting anything.

Further, what occurs in Herz is that the virtual channels are added to the scheduling list at the head end. But these added virtual channels are still directed to the same exact shows that were in the original line up (Herz, col. 26, lines 3-8 "[o]f course, in the case of scheduling at the set top multimedia terminal, the video programs scheduled onto 'virtual channels' are still received on their regular channels and the 'virtual channels' are assigned to unused channels of the set top multimedia terminal."). That is, the one scheduling list in Herz does not present any alternative shows, just the same shows on regular and virtual channels. Moreover, after a viewer views the one list, Herz does not request input from the viewer. In fact, in Herz, the viewer can view the list and select shows from the list, but the list is all inclusive. That is, all available shows for the viewer are contained in the list. The only thing Herz does based on the viewer's profile is update the virtual channels, but all the programming is still contained in the list. Thus, there simply cannot be a second list of alternative programming (Herz, col. 25, lines 61-64 "at

the set top multimedia terminal, the video programming database comprises only the video programming on those channels which the customer is authorized to receive.”). To clarify, the one list has regular channels and virtual channels that can be adjusted over time. The regular channels and virtual channels are simply not on two separate lists in Herz (see Herz, Fig. 9, single programming list 902).

Therefore, since Herz does not teach, disclose or suggest all of Applicant’s claims 20, 28 and 32 limitations, Applicant respectfully asserts that a *prima facie* rejection under 35 U.S.C. §102(b) has not been adequately set forth relative to Herz. Thus, Applicant’s amended claims 20, 28 and 32 are not anticipated by Herz. Additionally, the claims that directly or indirectly depend on claims 20 and 28, namely claims 21-27, and 29-31, respectively, are also not anticipated by Herz for the same reason.

Accordingly, withdrawal of the rejection of claims 20-32 is respectfully requested.

Applicant’s new claim 33 requires, in part, that the feedback is manually entered by the viewer. In Herz, the viewer does nothing and the profile is adjusted based on passive monitoring (Herz, col. 26, lines 57-60). Therefore, since Herz does not teach, disclose or suggest the limitations in new claim 33, new claim 33 could not be found anticipated by Herz.

Applicant’s new claim 34 requires, in part, that the alternative TV programs on the second list are each different from the TV programs on the first list. Since Herz only has one list of programs including duplicative shows on virtual channels, Herz cannot teach, disclose or

suggest the limitations in new claim 34. Therefore, since Herz does not teach, disclose or suggest the limitations in new claim 34, new claim 34 could not be found anticipated by Herz.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests that the rejections of the claims be withdrawn, and that the case be passed to issue. If the Examiner feels that a telephone interview would be helpful to the further prosecution of this case, Applicant respectfully requests that the undersigned attorney be contacted at the listed telephone number.

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Respectfully submitted,

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